



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,393	07/27/2005	Shirley Xiaoli Guo	11899.0236.PCUS00	2098

45607 7590 10/18/2007
HOWREY LLP
C/O IP DOCKETING DEPARTMENT
2941 FAIRVIEW PARK DRIVE SUITE 200
FALLS CHURCH, VA 22042

EXAMINER

KRUSE, DAVID H

ART UNIT	PAPER NUMBER
----------	--------------

1638

MAIL DATE	DELIVERY MODE
-----------	---------------

10/18/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/537,393

Applicant(s)

GUO ET AL.

Examiner

David H. Kruse

Art Unit

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 13-17, 20 and 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 18 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 6/2/2005.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☒ Other: Rule 105 Request.

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I, claims 1-12, 18 and 19, in the reply filed on 25 July 2007 is acknowledged. The traversal is on the ground(s) that the broadest incentive concept is bentgrass event ASR-368 (page 7, 3rd paragraph of the Remarks). Applicants' also argue that the bentgrass of Group IV is event ASR-368. This is not found persuasive because the DNA detection kit of Group II can be used to determine the absence of bentgrass event ASR-368 in a glyphosate tolerant bentgrass plant, in addition the bentgrass of Group IV encompasses events other than event ASR-368.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 13-17, 20 and 21 are withdrawn from further consideration pursuant to 37 CFR § 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 25 July 2007.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR § 1.48(b) and by the fee required under 37 CFR § 1.17(i).

Request for Information under 37 CFR 1.105

4. Applicant and the assignee of this application are required under 37 CFR § 1.105 to provide information that the examiner has determined is reasonably necessary to the examination of this application. See ATTACHMENT.

Claim Objections

5. Claims 1-3 are objected to because of the following informalities:

At claim 1, "Seed" should read -- A seed -- because a claim should be directed to a single invention.

At claims 2 and 3, line 1, "parts" should read -- part -- because a claim should be directed to a single invention, and to be in number agreement with "A" at claim 2.

Appropriate correction is required.

6. Claims 5-10 are objected to under 37 CFR § 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claims 5, 6 and 7 merely recite an inherent property of an event ASR-368 bentgrass plant and do not further limit the invention of claim 4.

At claims 8-10, the recitation of an intended use in the claim fails to further limit the bentgrass of claim 6.

7. Claim 12 is objected to under 37 CFR § 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper

Art Unit: 1638

dependent form, or rewrite the claim(s) in independent form. In the instant case SEQ ID NO: 12 and SEQ ID NO: 13 are primers that lie within the transgene insert, and if used would not produce an amplicon comprising SEQ ID NO: 1 or SEQ ID NO: 2.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

9. Claims 18 and 19 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 18, at line 3, refers to "bentgrass plant ASR-368" which appears to be an arbitrary designation, hence the claim is indefinite. The sole designation of a plant by its breeding line name or number is arbitrary and creates ambiguity in the claims. For example, the plant disclosed in this application could be designated by some other arbitrary means, or the assignment of the breeding line name could be arbitrarily changed to designate another plant. If either event occurs, one's ability to determine the metes and bounds of the claim would be impaired. See *In re Hammack*, 427 F.2d 1378, 1382; 166 USPQ 204, 208 (CCPA 1970). Amendment of the claim to refer to the deposit accession number of the claimed breeding line would obviate this rejection.

10. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Art Unit: 1638

11. Claims 1-12, 18 and 19 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The invention appears to employ novel plants. Since the plant is essential to the claimed invention it must be obtainable by a repeatable method set forth in the specification or otherwise be readily available to the public. If the plant is not so obtainable or available, the requirements of 35 USC § 112 may be satisfied by a deposit of the plant. A deposit of 2500 seeds of each of the claimed embodiments is considered sufficient to ensure public availability. The specification does not disclose a repeatable process to obtain the plant and it is not apparent if the plant is readily available to the public. It is noted that applicants have deposited the plant (page 23, lines 3-8 of the specification) but there is no indication in the specification as to public availability.

(a) If a deposit is made under the terms of the Budapest Treaty, then a statement, affidavit or declaration by Applicants, or a statement by an attorney of record over his or her signature and registration number, or someone empowered to make such a statement, stating that the instant invention will be irrevocably and without restriction released to the public upon the issuance of a patent, would satisfy the deposit requirement made herein.

(b) If a deposit has not been made under the Budapest Treaty, then in order to certify that the deposit meets the criteria set forth in 37 CFR §§ 1.801-1.809 and MPEP §§ 2402-2411.05, Applicant may provide assurance of compliance by statement, affidavit or declaration, or by someone empowered to make the same, or by a statement by an attorney of record over his or her signature and registration number showing that:

- (i) during the pendency of this application, access to the invention will be afforded to the Commissioner upon request;
- (ii) all restrictions upon availability to the public will be irrevocably removed upon granting of the patent in accordance with 37 CFR § 1.808(a)(2);
- (iii) the deposit will be maintained in a public depository for a period of 30 years or 5 years after the last request or for the effective life of the patent, whichever is longer;
- (iv) a test of the viability of the biological material at the time of deposit (see 37 CFR § 1.807); and,
- (v) the deposit will be replaced if it should ever become inviable.

12. Claims 11 and 12 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Art Unit: 1638

Applicants claim a bentgrass plant or seed, the genome of which produces an amplicon diagnostic for bentgrass plant ASR-368 when tested in a DNA amplification method that produces said amplicon from DNA extracted from said bentgrass plant or seed, wherein said amplicon comprises SEQ ID NO: 1 or SEQ ID NO: 2.

Applicants describe SEQ ID NO: 1 or SEQ ID NO: 2, 24 base pair primers comprising junction sequence of the ASR-368 transformation event. Also, Applicants describe a method for finding a "diagnostic" amplicon.

Applicants do not describe "an amplicon diagnostic of bentgrass plant ASR-368". Applicants do not describe other bentgrasses that produce such a diagnostic amplicon other than a bentgrass having event ASR-368.

Hence, it is unclear that Applicants were in possession of the invention as broadly claimed.

See, MPEP § 2163 which states that the claimed invention as a whole may not be adequately described where an invention is described solely in terms of a method of its making coupled with its function and there is no described or art-recognized correlation or relationship between the structure of the invention and its function. A biomolecule sequence described only by a functional characteristic, without any known or disclosed correlation between that function and the structure of the sequence, normally is not a sufficient identifying characteristic for written description purposes, even when accompanied by a method of obtaining the claimed sequence.

Conclusion

13. The claims appear to be free of the prior art.

14. No claims are allowed.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David H. Kruse, Ph.D. whose telephone number is (571) 272-0799. The examiner can normally be reached on Monday to Friday from 8:00 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg can be reached at (571) 272-0975. The central FAX number for official correspondence is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (571) 272-1600.

DAVID H. KRUSE, PH.D.
PRIMARY EXAMINER



David H. Kruse, Ph.D.
12 October 2007

16. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

ATTACHMENT

Request for Information under 37 CFR § 1.105

1. An issue of public use or on sale activity has been raised in this application. In order for the examiner to properly consider patentability of the claimed invention under 35 U.S.C. § 102(b), additional information regarding this issue is required as follows.

Applicant is reminded that failure to fully reply to this requirement for information will result in a holding of abandonment.

2. This request is being made for the following reasons:

The Federal Register Vol. 69, No. 2, pp 315-317, Monday, January 5, 2004 discloses in the right column, 4th paragraph, that ASR368 bentgrass has been field tested since 2000 in the United States under APHIS notifications.

Applicants and the Assignee of this application are required under 37 CFR § 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

The information is required to determine whether the plant was available to the public, accessibility of any foreign sales and the reproducibility of any plants that were sold to the public, more than one year prior to the effective filing date of this application.

In response to this requirement please provide:

a) information available regarding the first sale or other public distribution of the claimed plant anywhere in the United States more than one year prior to the effective filing date of this instant application, including date(s) and location of any sale or other public distribution including any public information available regarding sales, offers for

Art Unit: 1638

sale, or public distributions of the claimed plant that occurred more than one year prior to the effective filing date of this application, including information pertaining to whether this was an obscure, solitary occurrence that would go unnoticed by those skilled in the art;

b) evidence of any restrictions placed upon the propagation, further sale/resale, or other further distribution of the plant;

c) information about who was distributing the plant in the United States that occurred more than one year prior to the filing date of the instant application. Please also provide information about who was distributing the plant outside the United States that occurred more than one year prior to the filing date of the instant application;

d) information about the relationship between the distributor(s) and the inventor and/or the assignee.

3. If Applicant views any or all of the above requested information as a Trade Secret, then Applicant should follow the guidance of MPEP § 724.02 when submitting the requested information.

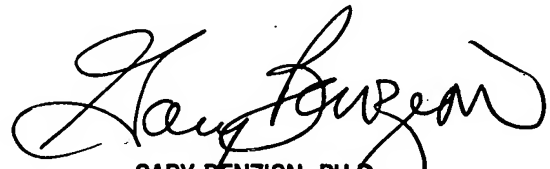
4. The fee and certification requirements of 37 CFR § 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 CFR § 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement

Art Unit: 1638

under 37 CFR § 1.105 are subject to the fee and certification requirements of 37 CFR § 1.97.

5. The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR § 1.56. Where the applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained may be accepted as a complete reply to the requirement for that item.

6. This requirement is an attachment of the enclosed Office action. A complete reply to the enclosed Office action must include a complete reply to this requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action.



GARY BENZION, PH.D
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600